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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/590,488 | 06/09/2000 | Dean F. Jerding | A-6600 | 2510 |

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SCIENTIFIC-ATLANTA, INC.
INTELLECTUAL PROPERTY DEPARTMENT
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EXAMINER

BELIVEAU, SCOTT E

ART UNIT PAPER NUMBER

2614

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/590,488

Applicant(s)

JERDING ET AL.

Examiner

Scott Beliveau

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38-69 is/are pending in the application.
- 4a) Of the above claim(s) 51-55 and 61-69 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 38-50 and 56-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 38-69 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 38-50 and 56-60, drawn to a method and apparatus for determining the existence of active VOD sessions, classified in class 725, subclass 93.
 - II. Claims 51-55 and 61-69, drawn to a method and apparatus for blocking programming based upon the number of , classified in class 725, subclass 29.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as the ability to determine the existence of active sessions and invention II has separate utility such as the ability to block programs based upon a defined number of rentals. See MPEP § 806.05(d).
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
5. During a telephone conversation with Mihn Nguyen on 01 November 2004 a provisional election was made with option to traverse to prosecute the invention of Group I, claims 38-50 and 56-60. Affirmation of this election must be made by applicant in replying to this Office

action. Claims 51-55 and 61-69 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Priority

7. With respect to the applicant's request for receiving benefit to an earlier filing date under 35 U.S.C. 119(e), it is the examiner's opinion that adequate support under 35 U.S.C. 112 for claims 38-50 and 56-60 is found in conjunction with the "Client User Interface Specification for Video-On-Demand Application Development on the Explorer 2000™ Digital Home Communications Terminal" by Shashi Goel. Accordingly, claims 38-50 and 56-60 receive the benefit of the earlier filing date of 11 June 1999.

Response to Arguments

8. Applicant's arguments with respect to claims 38-50 and 56-60 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

Art Unit: 2614

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 38-41, 56, and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goode et al. (US Pat No. 6,166,730) in view of Dunn et al. (US Pat No. 5,721,829).

In consideration of claims 38 and 56, the Goode et al. reference discloses a method implemented by a "digital home communication terminal (DHCT)" [118] comprising "memory" [518/520] implicitly storing "program code" so as to control the operation of the terminal via an interactive interface such as the OnSet™ system (Col 13, Line 60 – Col 14, Line 10). The method comprises "determining if at least one current rental exists" and "responsive to determining that at least one current rental exists determining whether an active video-on-demand (VOD) session for a first presentation exists" upon which the user is "provided a selectable option to view the first VOD presentation" (Figure 11; Col 17, Line 55 – Col 18, Line 33). The active program screen comprising the "selectable option" associated

with the OnSet™ system utilized in the Goode et al. reference is illustrated in Figure 17 of the Gordon et al. (US Pat No. 6,314,573).

The Goode et al. reference, however, is silent as to what occurs “responsive to determining that at least one current rental does not exist”. The Dunn et al. reference discloses a VOD system that “determines if at least one current rental exists” and “responsive to determining that at least one currently rental does not exist” it “provides a list of selectable VOD titles” (Col 7, Lines 20-34). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made so as to modify the Dunn et al. interface navigation so as to “provide a list of selectable VOD titles responsive to determining that at least one current rental does not exist” for the purpose of providing the user with a convenient means to facilitate the viewer’s browsing and ordering of video content if there are no current rentals and other inherent advantages associated therewith.

Claims 39 and 57 are rejected wherein “responsive to receiving the user input”, “configured to select the selectable option to view the first VOD presentation”, the apparatus “provides the first VOD presentation to a user” (Goode et al.: Col 18, Lines 29-33; Gordon et al.: Figure 17).

Claims 40 and 41 are rejected wherein the apparatus is operable to “receive a first user input configured to select a VOD title form the list of selectable VOD titles”, to “provide a selectable option for renting a second VOD presentation corresponding to the VOD title selected from the list of selectable titles”, and to “receive a second user input configured to select the selectable option for renting the second VOD presentation” (Goode et al.: Col 4, Line 55 – Col 5, Line 9; Col 14, Line 63 – Col 15, Line 33).

12. Claims 42-50 and 58-59 are rejected under 35 U.S.C. 102(e) as being anticipated by Goode et al. (US Pat No. 6,166,730), in view of Dunn et al. (US Pat No. 5,721,829), and in further view of Casement et al. (US Pat No. 5,969,748).

In consideration of claim 42-46, the combined teachings do not particularly disclose nor preclude the usage of determining whether or not selected presentations are blocked via both parental control and purchase access codes. The Casement et al. provides a method for renting a VOD presentation wherein “responsive to receiving the second user input, determining whether the second VOD presentation is blocked”, the apparatus “prompts a user to provide a third user input identifying a first access code for unblocking the presentation”, and “receives the third user input identifying the first access code” [100/102]. Subsequently to “responsive to receiving the third user input identifying the first access code” [102], the user is “prompted . . . to provide a fourth user input identifying a second access code” [106]. Accordingly, presuming that both the “first” and “second access codes” are correct, the apparatus “provides the user with the VOD presentation responsive to receiving the third user input” [110] (Casement et al.: Figure 3; Col 6, Lines 30-47). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combined teachings with that taught by Casement et al. for the purpose of advantageously providing a means to control access to television programs associated with both regular and on-demand programming (Casement et al.: Col 1, Lines 5-8, 26-63).

In consideration of claim 47, while Casement et al. discloses the particular usage of “key-strokes” in conjunction with the user input device (Col 3, Lines 51-65), the reference

does not explicitly disclose that the entry of the “first and second user inputs” are provided via a plurality of key-strokes”. Rather, the reference simply discloses that the passwords are entered, but does not particularly disclose how they are entered. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the aforementioned user input device so as to enter the multi-character passwords using a “plurality of key-strokes” for the purpose of providing a means or technique by which to facilitate the entry of the “first and second user inputs”.

Claim 48 is rejected wherein the “first and second access codes each includes a plurality of characters” (Casement et al.: Col 7, Lines 38-40).

Claim 49 is rejected wherein the “first user input enables the VOD presentation to be unblocked” (Casement et al.: Figure 4; Col 6, Line 48 – Col 7, Line 20).

Claim 50 is rejected wherein the “second user input enables the VOD presentation enables the VOD presentation to be rented” (Casement et al.: Figure 5; Col 7, Lines 21-31).

Claim 58 is rejected wherein the “program code is further configured to provide a second VOD presentation identified in the list of selectable VOD titles responsive to receiving a first user input selecting the second VOD presentation” (Goode et al.: Col 4, Line 55 – Col 5, Line 9; Col 14, Line 63 – Col 15, Line 33), a “second user input identifying a first access code, and a third user input identifying a second access code” (Casement et al.: Figure 3; Col 6, Lines 30-47).

Claim 59 is rejected wherein the “first user input enables the VOD presentation to be unblocked” (Casement et al.: Figure 4; Col 6, Line 48 – Col 7, Line 20).

Art Unit: 2614

Claim 60 is rejected wherein the "second user input enables the VOD presentation enables the VOD presentation to be rented" (Casement et al.: Figure 5; Col 7, Lines 21-31).


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 703-305-4907. The examiner can normally be reached on Monday-Friday from 9:00 a.m. - 6:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 703-305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SEB
November 3, 2004


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